

**REMARKS**

Claims 1 – 20 are pending in the application. Claims 1 – 20 have been rejected. Claims 1, 3, 8, 11 and 14 have been amended.

The Specification stands rejected under MPEP 608.01. The Specification has been amended to address this rejection.

Claims 1 and 8 stand rejected under Laor, U.S. Patent No. 6,584,448 B1 (Laor). Claims 14 and 17 – 19 stand rejected under Challener et al, U.S. Patent No. 6,654,886 B1 (Challener). Claims 12 and 13 stand rejected under Challener in view of Colligan et al., GB 2339488 (Colligan) in further view of Laor. Claims 15, 16 and 20 stand rejected under Challener in view of Laor. These rejections are respectfully traversed.

In general the present invention relates to enabling a benefit purchase incident to the purchase of a computer system by verifying the benefit based upon a service tag that is embedded within the computer system at the time of manufacture of the computer system. The value of the service tag uniquely identifies a computer system and is installed in the basic input/output system (BIOS) of the computer system. Storing the service tag in the system BIOS prevents the service tag from being lost such as when the hard disk is reformatted.

The present invention, as set forth by independent claim 1, relates to a method for purchase verification, comprising the acts of receiving at a server a first message from a computer system, determining at the server if the service tag is valid, and generating a second message from the server. The first message includes a service tag which uniquely identifies the computer system. The second message authorizes providing a benefit if the service tag is determined to be valid.

The present invention, as set forth by independent claim 4, relates to a method for purchase verification, comprising the acts of generating a service tag that uniquely identifies a computer system, the computer system including a processor coupled to a memory, storing the service tag in the memory at assembly of the computer system, receiving a message at a server sent from the computer system, the message including the service tag, verifying that the service

tag value as received matches a service tag value stored in the server, and authorizing receipt of a benefit if the received service tag matches.

The present invention, as set forth by independent claim 8, relates to a method for purchase verification of a benefit, comprising the acts of receiving a first message at a first server, transmitting a second message from the first server to a second server and transmitting from the second server a third message to the first server. The first message being sent from a computer system and includes a service tag which uniquely identifies a computer system. The second server attempts to verify the validity of the service tag. The third message allows access to the benefit.

The present invention, as set forth by independent claim 11, relates to a system in a computer system for purchase verification, the computer system includes a processor. The system includes a non-volatile computer readable memory. The non-volatile computer readable memory includes instructions, executable on the processor, configured to store a service tag installed upon assembly of the computer system, the service tag uniquely identifying the computer system; and instructions, executable on the processor, configured to send the service tag to a remote server.

The present invention, as set forth by independent claim 14, relates to a system for purchase verification, the system being on a server platform, the server operated by a service provider, the server configured to communicate with a purchased computer system, the server including a processor and a memory, the server platform configured to communicate with a remote computer system. The system includes a non-volatile computer readable memory. The non-volatile computer readable memory storing a database, the database including a set of valid service tags which correspond to computer systems that purchased a benefit, and instructions, executable on the processor, configured to receive a message, the message including a service tag which uniquely identifies a computer system.

Laor discloses a method for distributing and redeeming electronic coupons. The electronic coupon is represented as a data structure which includes for example, data representative of an electronic coupon serial number or identification number, data representative of a unique key that can be used to validate or authenticate the coupon, data representative of the

vendor that authorized the coupon and will redeem the coupon, data representative of the nature of the discount or access provided by the coupon, data representative of the server or entity that issued the coupon. (Laor, Col. 4, lines 5 – 15.) The data structure enables providing a benefit in the course of an online transaction based on a redemption function. The server can evaluate the electronic coupon to authenticate or validate the electronic coupon or alternatively, the server could transfer the electronic coupon information to an authentication server which could authenticate or validate the electronic coupon and authorize the transaction. (Laor, Col. 4, line 64 0 Col. 5, line 3.)

Challenger discloses a method for permitting only a pre-registered client computer to access a service executing on a server. A log-in token is established including a unique identifier which identifies a particular client computer. The client computer logs-on to the server. Subsequent to the client computer logging-on to the server, the client computer attempts to access the service. During the attempt, the client computer transmits the log-in token to the server. The server uses the unique identifier included within the log-in token to determine if the client computer is registered to access the service. In response to a determination that the client computer is registered to access the service, the server permits the client computer to access the service. In response to a determination that the client computer is not registered to access the service, the server prohibits the client computer from accessing the service.

Colligan discloses a protection technique that prohibits loading of a software image onto any computer hardware other than the computer hardware keyed to receive the software image. Reloading of the software image contained on a customer programmed CD ROM onto a hard disk drive of the computer is allowed only for a matched combination of a specific cross keyed customer programmed CD ROM, a specific associated bootable diskette and a uniquely keyed computer system. The uniquely keyed computer system is based upon, in part, the service tag of the computer system. Colligan sets forth that the service tag identifier specifically identifies a single computer. The service tag is typically a multiple character alphanumeric string that is programmed into a section of storage within the computer. In some systems, the service tag is stored within a hidden section of the nonvolatile memory during the manufacturing of the computer.

Laor, Challenger and Colligan, taken alone or in combination, do not teach or suggest a method for purchase verification which includes *determining at the server if the service tag is valid*, and generating a second message which authorizes providing a benefit *if the service tag is determined to be valid*, all as required by claim 1. Accordingly, claim 1 is allowable over Laor, Challenger and Colligan. Claims 2 and 3 depend from claim 1 and are allowable for at least this reason..

Laor, Challenger and Colligan, taken alone or in combination, do not teach or suggest a method for purchase verification which includes receiving a message at a server sent from the computer system, *the message including the service tag, verifying that the service tag value as received matches a service tag value stored in the server, and authorizing receipt of a benefit if the received service tag matches*, all as required by claim 4. Accordingly, claim 4 is allowable over Laor, Challenger and Colligan. Claims 5 - 7 depend from claim 4 and are allowable for at least this reason.

Laor, Challenger and Colligan, taken alone or in combination, do not teach or suggest a method for purchase verification of a benefit, comprising receiving a first message at a first server, transmitting a second message from the first server to a second server and transmitting from the second server a third message to the first server where the first message is sent from a computer system and includes *a service tag, the second server attempts to verify the validity of the service tag, and the third message allows access to the benefit*, all as required by claim 8. Accordingly, claim 8 is allowable over Laor, Challenger and Colligan. Claims 9 and 10 depend from claim 8 and are allowable for at least this reason.

Laor, Challenger and Colligan, taken alone or in combination, do not teach or suggest a system in a computer system for purchase verification having a non-volatile computer readable memory which includes instructions, executable on the processor, configured to store a service tag installed upon assembly of the computer system, the service tag identifying the computer system; and instructions, executable on the processor, configured to *send the service tag to a remote server to verify the purchase of a benefit*, all as required by claim 11. Accordingly, claim 11 is allowable over Laor, Challenger and Colligan. Claims 12 and 13 depend from claim 11 and are allowable for at least this reason.

Laor, Challenger and Colligan, taken alone or in combination, do not teach or suggest a system for purchase verification which is on a server platform and includes a computer readable memory storing a database, the database including a set of valid service tags, *the valid service tags corresponding to computer systems that purchased a benefit*, and instructions, executable on a processor of the server, configured to receive a message, the message including *a service tag*, all as required by claim 14. Accordingly, claim 14 is allowable over Laor, Challenger and Colligan. Claims 15 – 20 depend from claim 14 and are allowable for at least this reason.

Additionally, applicants respectfully submit that the combination of Laor, Challenger and Colligan is improper because Laor, Challenger and Colligan are nonanalogous prior art that have been combined with the benefit of hindsight and because Laor, Challenger and Colligan fail to provide a suggestion to be combined.

Laor, Challenger and Colligan are nonanalogous prior art because Laor relates to redeeming electronic coupons, Challenger relates to permitting access to a service executing on a server and Colligan relates to prohibiting loading of a software image on to a computer.

The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself .... *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d, 1443, 1446 (Fed. Cir. 1992)

Additionally, even if Laor, Challenger and Colligan are found to be within analogous arts, neither Laor, Challenger or Colligan provide a suggestion for such a combination.

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. Wilson and Hendrix fail to suggest any motivation for, or desirability of, the changes espoused by the Examiner and endorsed by the Board.

Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed

invention. *In re Fritch*, 23 USPQ 2d at 1783-84 (quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988)).

Further, it appears that the rejection of claims 1 – 20 is based on an improper hindsight-based obviousness analysis. In this regard, it must be recognized that hindsight reconstruction of claims based on disparate aspects of the prior art may not be employed as a valid basis for the rejection of those claims. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 USPQ 303, 312-313 (Fed. Cir. 1983); *Panduit Corp. v. Dennison Manufacturing Co.*, 1 USPQ2d 1593, 1595-1596 (Fed. Cir. 1987). Furthermore, an obviousness determination requires that the invention as a whole would have been obvious to a person having ordinary skill in the art. *Connell v. Sears Roebuck & Co.*, 220 USPQ 193 (Fed. Cir. 1983).

To establish obviousness based on a combination of elements disclosed in the prior art or a modification of the prior art, there must be some motivation, suggestion or teaching of the desirability of making the claimed invention. See *In re Dance*, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984). The motivation, suggestion or teaching to modify references may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Whether the Office Action relies on an express or implicit showing of a motivation or suggestion to modify or combine references, it must provide particular findings related thereto. *In re Dembiczak*, 50 USPQ2d at 1617. Broad conclusory statements standing alone are not “evidence.” *Id.* Thus, the Office Action must include particular *factual findings* that support an assertion that a skilled artisan would have modified the express disclosure of Laor, Challenger and Colligan to develop the invention recited by independent claims 1, 4, 8, 11, and 14. See *In re Kotzab*, 55 USPQ2d 1313, 1317. Applicant is unable to discern the requisite factual basis in Laor, Challenger and Colligan or the Office Action.

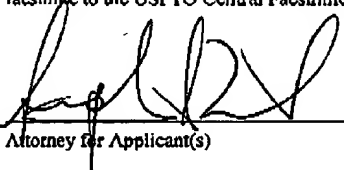
In this regard, the Office Action appears to have engaged in a hindsight-based obviousness analysis condemned by the Federal Circuit. To prevent a hindsight-based obviousness analysis, the Federal Circuit has clearly established that the relevant inquiry for determining the scope and content of the prior art is whether there is a reason, suggestion, or motivation in the prior art or elsewhere that would have led one of ordinary skill in the art to

combine or modify references. See *Ruiz v. A.B. Chance Co.*, 57 USPQ2d 1161, 1167 (Fed. Cir. 2000); see also *In Re Rouffet*, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) (“[T]he Board must identify specifically ... the reasons one of ordinary skill in the art would have been motivated to select the references and combine them to render the claimed invention obvious.”). Applicant can detect, and the Office Action has pointed to, no motivation or suggestion that would prompt someone of ordinary in the art to look to Laor, Challenger and Colligan in combination for a solution to the problem addressed by Applicant’s invention. Such a determination that there is a suggestion or motivation to modify Laor, Challenger and Colligan is a factual finding that is prerequisite to an ultimate conclusion of obviousness. *Sibia Neurosciences, Inc. v. Cadus Pharma. Corp.*, 55 USPQ2d 1927, 1931 (Fed. Cir. 2000). Applicant respectfully submits that the Office Action is devoid of such a finding.

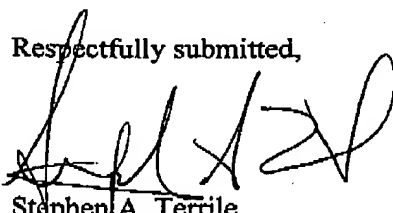
Without such a finding, a *prima facie* case of obviousness in rejecting claims 1 – 20 under 35 U.S.C. § 103(a) based on Laor, Challenger and Colligan has not been made. For this further reason, Applicant respectfully submits that claims 1 - 20 are patentably distinguished over Laor, Challenger and Colligan and Applicant respectfully requests the Examiner to remove the rejections of claims 1, 4, 8, 11, and 14 and the claims depending therefrom.

### CONCLUSION

In view of the amendments and remarks set forth herein, the application is believed to be in condition for allowance and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the examiner is requested to telephone the undersigned.

I hereby certify that this correspondence is being sent via facsimile to the USPTO Central Facsimile on October 4, 2004.	
	10/4/04
Attorney for Applicant(s)	Date of Signature

Respectfully submitted,

  
Stephen A. Terrile  
Attorney for Applicant(s)  
Reg. No. 32,946